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10/033,401	12/26/2001	Scott A. Rosenberg	03-380-C	1472

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EXAMINER	
CARLSON, JEFFREY D	

ART UNIT	PAPER NUMBER
3622	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/033,401	ROSENBERG, SCOTT A.	
	Examiner	Art Unit	
	Jeffrey D. Carlson	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,7-10,12,13,20,21,23 and 26-36* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,7-10,12,13,20,21,23 and 26-36* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to the paper(s) filed 4/30/2009.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 26 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Claim 26 requires transparency, yet the only support for such in the disclosure appears to be the description of figure 5(c) [PGPUB 0074], yet this embodiment is not one which can be fairly described by the limitations of base claim 1. There is no disclosure to support a wiped ad that includes at least partial transparency.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 34 purports to further limit the software product of claim 20, but the claim merely indicates where the software product is located. It is not clear how the location of a software product further defines the software product. What additional instructions of the software product are being claimed in this claim?

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 1, 7-10, 12, 13, 20, 21, 23, 26-28, 31, 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice.**

7. Regarding claims 1, 20, 21, 27-28, 33-36, Barton teaches a DVR (connected to a display device of a TV) with software that enables a user to select (during a first mode where figure 2's menu/index/list of pre-recorded programs is offered on the screen) a program for requested playback. Barton teaches a bookending function which can insert and play advertising before the user-selected, pre-recorded program is played.

The bookending function also may play advertising after the program playback [abstract, 0014]. Both the beginning and end of the requested program content are taken to represent detections of a mode change and trigger obtaining/determination of an appropriate advertisement. Regarding the claimed feature that the advertising is displayed simultaneously with the video of the modes, it is unstated in Barton whether or not there is any simultaneous display of 1st mode (the index/menu) with the ad or whether or not there is any simultaneous display of the ad with the 2nd mode (the requested program). However it is clear that Barton teaches a sequence of 1st mode (index/menu),...advertising...2nd mode (the requested program). Official Notice is taken that it was well known to enhance video content by including visual transitions between portions of video content. One typical video transition has been traditionally referred to as a "wipe" – much as applicant describes in his figure 3(d) and referred to as a "wipe" in the instant specification and current claims. A long time ago George Lucas used this technique heavily in the Star Wars original trilogy (1977+) whereby a first scene (first video mode) was wiped over by a second scene (second video mode). In the middle stages of this wipe, both scenes were simultaneously on the screen but without overlap. One of ordinary skill has understood that video transitions such as a wipe (and others such as dissolve, fade, blinds, etc.,) help smooth or create fanciful transitions between different video portions. It would have been obvious to one of ordinary skill at the time of the invention to have provided any of such well known transitions including vertical or horizontal wipes between the "modes" of Barton (menu transitions into the ad; the ad transitions into the selected program). By doing such a wipe, Barton's index would be

displayed simultaneously on the screen as the ad, but would eventually be wiped off the screen by the ad. Likewise, the end of the advertising content would be wiped off the screen with the start of the selected program.

8. Regarding claims 7-10, 13, Barton teaches that the ads are pre-stored on the device and that they can be selected on the basis of the viewer's preferences and personal information [0015]. This is taken to provide a real-time and dynamic selection of ads based upon previously collected user information. Claim 10's "context information" is quite broad and could be met by virtually any information used for the bookend feature: the context that there is a transition to the start of a requested program, the context that there is a transition from the end a requested program, the context that the ads are targeted to the audience that the viewer is a part of [0015], the context of the genre, etc. The bookend programming/functionality [fig 9: 904] is taken to provide an ad placement engine.

9. Regarding claim 12, while any moving video content can be taken to be animation (i.e. simple motion), Official Notice is taken that TV commercials have for decades included cartoon animation, such as the Snap, Crackle and Pop characters for Kellogg's Rice Krispies ™. It would have been obvious to one of ordinary skill at the time of the invention to have provided at least some of the advertisements of Barton as animations in a manner as well known.

10. Regarding claim 23, Official Notice is taken that some TV advertising has for years included a still image (for example a textual ad for a business which textually lists the name, address and phone number of the business) which is rendered as video

frames for a period of time long enough for a viewer to read the pertinent information. Another example is the ubiquitous FBI warning message text screen that has accompanied purchased/rented movies for many years before applicant's filing date. It would have been obvious to one of ordinary skill at the time of the invention to have inserted any such type of advertising, including a replicated still frame.

11. Regarding claim 26, an ad for a new car that shows the car (including the transparent windows) can be taken to be an ad that is partially transparent. It would have been obvious to one of ordinary skill at the time of the invention to have shown such a visual representation of a car if a car dealer wanted to purchase advertising to sell his cars.

12. Regarding claim 31, Barton teaches downloading of the ads from a server [0049]. They are then stored obtained from memory when needed for display.

13. **Claims 29, 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Borchardt et al (US5272525).**

14. Regarding claims 29, 30, Barton does not specify how the display device is connected to the DVR, however Borchardt et al describes typical connections between video sources hardware and TV displays as being wired [1:20-27] or as wireless transmissions [abstract]. It would have been obvious to one of ordinary skill at the time of the invention to have connected the DVR hardware of Barton in any such known manner.

15. **Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barton (US2001/049820) in view of Official Notice as above, and further in view of Klug (US2003/0195797).**

16. Regarding claim 32, Barton teaches targeting advertising to a user's preferences such as types of programming (e.g. sci-fi), but does not explicitly teach the use of a program title. Klug teaches targeted advertising to television programming and teaches that the programs title can be used as a basis to determine appropriate advertising [0032]. It would have been obvious to one of ordinary skill at the time of the invention to have used such title-based targeting with the invention of Barton in order to provide relevant advertising to the viewer.

Response to Arguments

17. Applicant argues Barton and Chen and examiner has removed the rejections based on Chen because the claims no longer call for overlays, mini ads, transparency, etc. The claims now explicitly exclude overlap, yet they do include two modes being on the screen simultaneously. This was partially addressed previously by the mention of a wipe transition. Because the claims now essentially specify a wipe transition, examiner has tailored the rejection based on Official Notice of the traditional wipe technique. Examiner also no longer needs to rely on other transitions such as the "dissolve" which arguably may be interpreted as providing visual overlap, something the base claims appear to exclude.

18. Applicant appears to argue the Official Notice taken. Applicant is seen to disagree with the subsequent conclusion of obviousness rather than the assertion of facts (video transitions of wipes, etc., were notoriously well known). If applicant makes a proper challenge to the assertion of facts, examiner may provide a reference showing these facts. The "gaps" bridged by obviousness based on the facts of official notice are gaps that are consistent with the traditional use of the video wipe transition. Applicant appears to be aware of this tradition in that applicant uses the well known term in the art, "wipe". One of ordinary skill would expect a wipe to be predictably effective for transitioning video modes of Barton's DVR video modes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Monday-Fridays; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey D. Carlson/
Primary Examiner, Art Unit 3622

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